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EXAMINER

HEINCER, LIAM J

ART UNIT

PAPER NUMBER

1796

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

Response to Amendment

The declaration under 37 CFR 1.132 filed April 8, 2009 is insufficient to overcome the rejection of claims 1 and 3-6 based upon Calundann (US Pat. 4,219,461) as set forth in the last Office action because: The declaration is not sufficient to show the unexpected nature of the resins melting point. See response to arguments below..

Response to Arguments

Applicant's arguments filed April 6, 2009 have been fully considered but they are not persuasive, because:

A) In response to applicant's argument that the polymers have a lower melting point than those used in the preferred embodiments of Calundann, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

While applicants declaration under Rule 1.132 clearly shows that the preferred embodiment of Calundann (Example 1) does not possess the claimed melting point, the declaration is not sufficient to show that the broad disclosure of Calundann would not be expected to have the claimed melting point. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). See MPEP 2123. As the broad disclosure renders the claimed monomer ratios obvious, evidence would be required to show that the claimed property would be unexpected. Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). See MPEP § 2145.

B) In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed

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knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

C) Applicants argument that Calundann teaches away from resins with melting points below 250 C is not persuasive. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). See MPEP § 2123. Although Calundann prefers polyesters with melting points of at least 250 C, and most prefers polyesters with melting points of 280 to 300C (3:25-52), the reference does not provide any disincentive to go below these preferred ranges. Additionally, the language "[t]he crystalline polyester commonly exhibits a melting point of at least 250° C..." shows that Calundann envisions that lower melting points could be achieved.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liam J. Heincer whose telephone number is 571-270-3297. The examiner can normally be reached on Monday thru Friday 7:30 to 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Harold Y Pyon/
Supervisory Patent Examiner, Art
Unit 1796

LJH

April 8, 2009